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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,854

09/10/2003

Dong Kyu Lee

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5037

35884

7590

10/20/2008

LEE, HONG, DEGERMAN, KANG & WAIMEY

660 S. FIGUEROA STREET

Suite 2300

LOS ANGELES, CA 90017

EXAMINER

AL AUBAIDI, RASHA S

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

10/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/659,854	<b>Applicant(s)</b> LEE, DONG KYU	
	<b>Examiner</b> RASHA S. AL AUBAIDI	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 1-16 and 21.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |



## **DETAILED ACTION**

### ***Response to Amendment***

1. This in response to amendment filed 07/03/2008. No claims have been added. No claims have been canceled. Claims 1, 9 and 21 have been amended. Claims 1-16 and 21 are still pending in this application.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda (US PAT # 5,233,641) in view of Breeden et al. (US PAT # 5,202,912) and further in view of Chung et al. (Pub. No.: 2003/0002476).

Maeda teaches a method for generating a ring back tone, (see col. 4, lines 5-6), the method comprising: receiving by a first terminal a request (this reads on telephone set 10 (S20), see col. 3, lines 63-68) for a call set up generated by a second terminal (reads on base station 30, see col. 3, lines 61-67); generating a ring back tone data by the first terminal (see col. 4, lines 5-7); inserting the ring back tone data into a response (see col. 4, lines 10-16) message sent from the first terminal (telephone set 10) to the

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second terminal (base station 30); and transmitting the response message (see col. 4, lines 3-23) from the first terminal (telephone set 10) to the second terminal (base station 30).

Maeda does not specifically teach that the second terminal will generate a ring back tone in response to receiving a response message.

However, Breeden teaches that a base station will generate a dial tone in response to receiving an "authorization response" (see col. 5, lines 5-9).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of having the base station generating a tone, as taught by Breeden, into the Maeda's system in order to provide the user with conformation of receiving and acknowledging the response message sent from the first terminal. One obviously can choose the base station to generate any type of response. This is considered a design choice by the Applicant.

The combination of Maeda and Breeden does not specifically teach that the first terminal communicates over (VOIP) network (i.e., internet) and the second terminal communicates over PSTN.

However, Chung teaches a communication between two phones (first and second terminal) located in two different networks (internet and PSTN), the phones communicates via gateway as shown in Figs. 1-3.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to establish communication between two different terminals located in two different networks, as taught by Chung, into the combination of Maeda and Breeden in order to provide a ring back tone utilized among subscribers located in different networks. This will enhance the system's diversity and provide unlimited features to subscribers in different types of networks. Also, initiating communication using a data network (such as the Internet) is old and well-known feature in the telephony art. Thus, generating and transmitting the ring back tone between the two stations using the Internet is more economical.

Claims 8-9 and 21 are rejected for the same reasons as discussed above with respect to claim 1. The claimed feature of "decision section for deciding whether to generate a ring back tone ...etc" as recited in claim 9, is extremely obvious. These kinds of decisions are made in seamless matter that requires no intervention from a user. The claimed "signal processor" as recited in claim 9, reads on data processing circuit 13 (see col. 2, lines 43-46)

Regarding claims 2 and 10, Chung teaches the use of real-time protocol [see 0029].

Claims 3 and 12 recite “storing the ring back tone data; and reading the stored ring back tone data according to a “first-in first-out” method so as to insert the ring back tone data to the response message”. Storing a ring back tone data cording to a “first in first out” is obvious, since “first-in first-out” method is old and well known in the art in the queuing system.

Regarding claims 4 and 13, Chung teaches providing appropriate voice tuning depending of the type of connection [see 0017].

Claims 5-6 and 14-15 limitation are obvious and well known in the art. One can obviously set any kind of identification parameters such as phone number, prefix, and type of the call, time or the day ...etc.

Regarding claims 7 and 16, this can reads on the user going off hook (see col. 4, lines 5-8 of Maeda). Obviously when a user goes off hook and answers the call there is no more ring back tone generated.

### ***Response to Arguments***

3. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S AL-Aubaidi whose telephone number is (571) 272-7481. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (571) 272-7488.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rasha S AL-Aubaidi/

Primary Examiner, Art Unit 2614